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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,465	12/19/2000	Douglas R. Olsen	11USF	4054

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EXAMINER	
BOS, STEVEN J	

ART UNIT	PAPER NUMBER
1754	9

DATE MAILED: 08/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MS

Office Action Summary

Application No.	Applicant(s)
09/740,465	Olsen et al
Examiner	**Art Unit**
Steven Bos	1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 5, 2002*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above, claim(s) *11-14* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-10 and 15-22* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-22* are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *3,4*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *Memo (Copy of Papers Originally Filed)*

Applicant's election with traverse of claims 1-10,15-22 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the Office action has no support that these inventions are distinct and have acquired a separate status in the art as shown by their different classification, and that the search required for Group i is not required for Group II. This is not found persuasive because MPEP 806.05(e) states that apparatus claims to "means" for practicing the process is a linking claim which must be examined with the elected invention, but only to the extent necessary to determine if the linking claim is unpatentable. If the linking claim is unpatentable, restriction is proper. In the instant case the linking claim is unpatentable as shown by Canada 956553 or EP 32886. See pp. 6-9 of CA '553 and pp. 7-9 of EP '886.

The requirement is still deemed proper and is therefore made FINAL.

Claims 11-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

The disclosure is objected to because of the following informalities: on pg. 16, line 15, "35-0" is questioned; it appears that --350-- was intended.

Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9,10,16,20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, "the stoichiometric amount" is indefinite as to what this refers to; ie. the stoichiometric amount of what?

In claim 10, "the metal pickling process" lack(s) proper antecedent basis in the claim(s).

In claim 16, "the ferrous metal pickling process" lack(s) proper antecedent basis in the claim(s).

In claim 20, "the stoichiometric amount" is indefinite as to what this refers to; ie. the stoichiometric amount of what?

In claim 21, "to provide pickling" is indefinite as to what this means; it appears that --to pickle the metal-- or the like was intended.

In claim 21, c, "said solution" is indefinite as to which solution this is the one in a or the one in b.

In claim 22, "regenerating pickling a metal" is awkward, indefinite and ungrammatical.

In claim 22, "at a certain temperature" is indefinite as to what is considered to be a certain temperature.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,6,8,10,15,16,18,21,22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Canada 956553 or EP 032886. See pp. 6-9 and 7-9, respectively.

Claim 22 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by DE 4122920 or Morimoto '664 or Senior '306. See the abstract of each.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10, 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canada 956553.

CA '553 teaches the instantly claimed process of adding an acid such as sulfuric acid to a pickling solution of ferrous chloride and HCL to regenerate the HCL and form ferrous sulfate heptahydrate which is then crystallized and removed. See pp. 6-9.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within

the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results, see In re Boesch, 205 USPQ 215.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, In re Malagari, 182 USPQ 549.

Claims 1-10,15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 32886.

EP '886 teaches the instantly claimed process of adding an acid such as sulfuric acid or phosphoric acid to a pickling solution of ferrous chloride and HCL to regenerate the HCL and form ferrous sulfate heptahydrate which is then crystallized and removed. See pp. 7-9.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results, see In re Boesch, 205 USPQ 215.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, In re Malagari, 182 USPQ 549.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Bos whose telephone number is (703) 308-2537. The examiner is on the increased flexitime program schedule. The FAX No. for After Final amendments is 703-872-9311; for all others it is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Steven Bos
Primary Examiner
Art Unit 1754